

REMARKS

Claims 17-19 and 21-29 are pending. Claim 20 has been canceled and its feature has been added to the independent claims.

Interview Summary

On June 1, 2009 examiner Arnold sent the undersigned a courtesy copy of Rump. Between that time and the issuance of the Office Action of June 26, 2009, the undersigned and Examiner Arnold had a few telephone conversations about claims 17 and 20. An agreement was not reached. Examiner Arnold informed the undersigned that he would give a new rejection in view of Rump.

Rejection Under 35 U.S.C. §112, second paragraph

Claims 17-29 have been rejected in light of the alleged amendment to claims 17 and 22 to change the term consisting to comprising. This alleged amendment was made in response to a final office action. The examiner did not enter the amendment. In the RCE of April 17, 2009, the Applications specifically stated that such amendment to the claims is not being made:

Claims 17-29 are pending. The Examiner did not enter the amendment after final for the reason that the claims were amended to recite the term comprising. In order to expedite prosecution, the Applicant has decided to pursue the previously presented claims and not to amend the claims.⁵

Since the examiner never entered the amendment after final, claims 17 and 22 recite the term “consisting” and the rejection does not apply.

Rejection Under 35 U.S.C. §103

The determination of obviousness under 35 U.S.C. § 103(a) is based upon the factual inquiries set forth by the U.S. Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 17-18. These factual inquiries are: determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims in issue; resolving the level of ordinary skill in the pertinent art; and evaluating evidence of

secondary considerations. *Id.* In formulating an obviousness rejection based upon a combination of prior art elements, it is necessary for the Office to identify a reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. When performing this analysis,

[I]t will often be necessary to look to interrelated teachings of multiple patents; to the effect of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 127 S. Ct. 1727, 1740-41 (2007).

The Examiner has rejected the claims as unpatentable over Rump et al. in view of Doerfler et al. As amended, the claimed components of ratios for components a, b and c do NOT overlap with Rump.

Rump uses a 5-6 French catheter, and teaches use of a 3 French catheter where “catheterization proved impossible.” The present applicant has found that the ethibloc can be administered with a 1.2 French catheter when using a mixture within the claimed ratio. This substantially smaller catheter size allows accessing much smaller arteries in the body. Additionally, the Applicant has found that a long window of time for administration exists when using the claimed ratios. Despite the additional amount of ethanol and its advantages of allowing for the use of a small catheter and a longer window of operation, the embolization provided is substantially effective. There is no teaching in Rump that embolization can be carried out with a ratio of ingredients that is outside of its disclosure, and yet be able to use a 1.2 French catheter and have a long window for operation.

The Doerfler reference relates to a mixture of Ethibloc and Lipiodol for embolic purposes. The Lipiodol is used to lower the viscosity of the Ethibloc, *i.e.*, the Lipiodol is a diluent and a contrast medium at the same time. This technique of

Doerfler is described in the passage bridging pages 3 and 4 of the present application. The mixture of Ethibloc and Lipiodol has a big disadvantage in that it results in a suspension which rapidly separates. Rapid separation is of no problem, if treatment can be carried out in a short time. However, in all applications where the physician needs more time, this separation prohibits a homogenous filling of vascular malformations. The mixture becomes inhomogenous and results in an insufficient embolization with the possibility of recanalization.

The combination of Rump and Doerfler fails to teach the claimed invention. Doerfler teaches using the Lipidol as a diluent. The ratios of component to each other in Rump and Doerfler is different, and there is no teaching which components to modify. Even if the modification were done solely according to Rump, an assumption in the Office Action, the ratios would still not overlap with the claimed ratios.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that the present application is in condition for allowance. Early and favorable action by the Examiner is earnestly solicited. If any outstanding issues remain, the examiner is invited to telephone the undersigned at the telephone number indicated below to discuss the same.

Respectfully submitted,

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